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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/941,132	09/30/1997	YASUYUKI TANAKA	0649-SP0619P	5656

2292 7590 07/31/2003
BIRCH STEWART KOLASCH & BIRCH
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EXAMINER

ZITOMER, FRED

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/31/2003

46

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/941,132	TANAKA ET AL.	
	Examiner	Art Unit	
	Fred Zitomer	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 11 April 2003 and 08 May 2003.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-3 and 7-32 is/are pending in the application.

4a) Of the above claim(s) 9-27 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-3, 7, 8 and 28-32 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☒ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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1.

This responds to the communications of April 11, 2003 and May 8, 2003. The rejection of record of claims 1-3, 7 and 8 under 35 USC 112, first paragraph, is withdrawn in view of applicant's amendments. The rejection of record under 35 U.S.C. § 103 over Yasuyuki et al., EP 0 584 597, taken with Kondo et al., US 4,208,490, or Burlett et al., US 5,118,546, or Hayashi et al., US 4,528,340, is maintained for the claims of Group I as noted below. No claim is allowed.

2.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3.

Claims 1-3, 7, 8 and 28-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Yasuyuki et al., EP 0 584 597, taken with Kondo et al., US 4,208,490, or Burlett et al., US 5,118,546, or Hayashi et al., US 4,528,340.

The grounds of rejection are adequately set forth in the prior Office action(s).

4.

Applicant's arguments filed April 11, 2003 have been fully considered but they are not persuasive. The essence of said arguments is that unexpected results in the way of enhanced grafting and epoxidation rates are realized with deproteinized natural rubber. By way of reply it is noted that the arguments repeat earlier arguments which have been addressed and found to be non-persuasive in prior Office actions. See e.g. the responses given in the Examiner's Answer [Paper no. 33] and the decision by the Board Of Patent Appeals And Interferences [Paper no.

37]. In sum, it has been held that the chemical, physical and physiological advantages of deproteinized rubber were known at the time of the instant invention and that even if the specific advantages now being claimed were not known, unexpected results do not outweigh expected results.

It is noted that the present revisions to the claims relating to preparing deproteinized natural rubber with nonionic surfactants or a combination of nonionic and anionic surfactants are not deemed to impact patentability. More directly, applicant admits that the deproteinized natural rubber and instant surfactants are disclosed in the prior art [Applicant's disclosure page 7, second complete paragraph – page 8, paragraph 2]. EP – A – 0 584 597 for example teaches natural rubber prepared with the instant surfactants [page 6, lines 19-58].

5.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



**FRED ZITOMER, PhD
PRIMARY EXAMINER
ART UNIT 1713**

Zitomer/fz
July 26, 2003